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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,004	10/01/2003	Christina Hsu	200208014-1	7237
22879 7590 01/02/2009 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER DAO, THUY CHAN	
			ART UNIT 2192	PAPER NUMBER
			NOTIFICATION DATE 01/02/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/677,004	Applicant(s) HSU ET AL.	
	Examiner Thuy Dao	Art Unit 2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief (hereafter "Brief") filed on October 9, 2008, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

2. Claims 1-24 have been examined.

3. From the record, in the Amendments filed December 17, 2007, the Applicants added new limitations "a *cached* configuration file that originated from a backend data store" (e.g., claim 1, line 8) without pointing out the support and argued as an allowable subject matter.

In the subsequent Office action mailed March 28, 2008 (pp. 2-3), claims 1, 8, 15, and 22 have been objected to.

After further consideration of the Brief (e.g., Summary of Claimed Subject Matter, page 5) and the originally filed disclosure, the examiner confirmed that the originally filed disclosure does not support the particular limitations "a *cached* configuration file that originated from a backend data store". In this Office action, the examiner establishes a new ground of 35 USC section 112 rejection as set forth in details below.

Response to Arguments

4. Applicants' arguments have been considered.

a) First Ground of Rejection – Claim 1-7 and 15-21 are rejected under 35 USC section 101 as being directed to non-statutory subject matter (Brief, pp. 9-19).

The Appellants stated, *"First, Appellants respectfully submit to the Board that the recited 'configurator generator' and 'controller generator' of independent claim 1 would clearly be understood by one skilled in the art to encompass more than 'only software components'"* (page 15, last paragraph, emphasis added).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Brief, page 16, line 6: *"at least some hardware is required"*; page 16, lines 16-17: *"a system' ... encompassing at least some hardware elements"*; page 17, lines 11-12: *"means" as "processor-based device such as a computer system or the like"*; and page 19, lines 10-11: *"system" "clearly directed towards a machine"*) are not recited in the rejected claim(s) – emphasis added.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Per the plain language, claims 1-7 and 15-21 direct to "a system", which may comprise only software programs such as "a controller generator", "a configurator generator" as recited in independent claim 1 and "means for creating a controller", "means for creating a configurator" as recited in independent claim 15, which are non-statutory subject matters.

a) Second Ground of Rejection – Claim 1-24 are rejected under 35 USC section 102(b) as being anticipated by Hutsch (Brief, pp. 20-33).

In this Office action, the examiner establishes a new ground of rejection in view of Hutsch (art of record) as set forth in details below.

Claim Rejections – 35 USC §101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. As set forth in the previous Office actions mailed March 28, 2008, September 12, 2007, January 26, 2007, and August 7, 2006, claims 1-7 and 15-21 are rejected because the claimed invention is directed to non-statutory subject matter. They amount to Functional Descriptive Material: "Computer Programs" representing computer listings per se.

Claims 1 and 15:

Claims 1 and 15 recite "*A system for creating web applications ...*", which may comprise only software programs (i.e., "*a controller generator*" 102 and "*a configurator generator*" 116, which can be implemented as a Servlet, [0019], lines 7-10).

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions (emphasis added). See MPEP 2106.01(I).

Claims 2-7 and 16-21:

Claims 2-7 and 15-21 further recite functional descriptions of said software programs and do not remedy the deficiencies of independent claims 1 and 15, respectively.

Under the principles of compact prosecution, claims 1-7 and 15-21 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example, - -A system stored on a machine readable medium for creating web applications, ...- - as similarly recited in currently pending (and originally filed) independent claim 22 (lines 2 and 6).

Claim Rejections – 35 USC §112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 8, 15, and 22:

The limitations at issue “a cached configuration file that originated from a backend data store” (e.g., claim 1, line 8, emphasis added).

As clearly acknowledged in Brief, page 5, the Appellants mapped the claimed limitation “a cached configuration file” to “Configuration file 212” in FIG. 3, which is also illustrated as “Configuration file 152” in FIG. 2.

That is to say, the originally disclosure merely discloses “*Configuration file 152*” (FIG. 2) and “*Configuration file 212*” (FIG. 3), but does not disclose any “cached configuration file”.

Furthermore, the originally filed disclosure clearly sets forth:

“[0037] The configurator 210 may have the purpose of providing a centralized way of loading startup objects that may be required during the operation of the web application 204. For example, the configurator 210 may be adapted to load data from the configuration file or files 212 upon execution of the init() method of the controller 208. Data loaded by the configurator 210 may be stored in one or more configuration files 212, which may comprise one or more text properties configuration files or the like. After data from the configuration file or files 212 is loaded by the configurator 210, the data may be stored as a singleton object 214. A singleton object is an object that exists in memory such that only one of that type of object exists at any time in memory. Once created, a singleton object is not destroyed after use, like most objects, but is kept in memory until accessed again” (i.e., the data loaded by the configurator 210 is cached and stored as a singleton object 214, but not the configuration file(s) 212 is cached, emphasis added).

Accordingly, nowhere in the originally filed disclosure discloses “*a cached configuration file*” and as acknowledged Brief, section “Summary of Claimed Subject Matter”, the Appellants mapped the limitation at issue “*a cached configuration file*” to “*Configuration file 212*” - see Brief, page 5, line 8; page 6, line 12; page 7: last line - page 8, first line; and page 9, line 12).

In light of the originally filed disclosure, in this Office action, the examiner treats the particular limitation “*a cached configuration file*” as - *-a [[cached]] configuration file--*.

Claims 2-7, 9-14, 16-21, and 23-24:

Claims 2-7, 9-14, 16-21, and 23-24 are also rejected based on virtue of their dependencies on the rejected base claims 1, 8, 15, and 22, respectively.

Claim Rejections – 35 USC §102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutsch (art of record, US Patent Publication No. 2001/0034771 A1).

Claim 1:

Hutsch discloses *a system stored on a machine readable medium for creating web applications* (e.g., FIG. 3A, [0115]; FIG. 8, [0234-0245]), *the system comprising:*

a controller generator (e.g., FIG. 8, Web Server 320, [0124], [0145]-[0146]) *that is adapted to provide a web application with a controller that receives a request for data from a user* (e.g., FIG. 8, user Web Browser 304, [0118] and [0162]) *and responds to the request by sending information to the user* (e.g., FIG. 8, Web Server 320 provides web applications to user Web Browser 304 after receiving HTTP requests from said user Web Browser 304, [0145]-[0146]; FIG. 15, [0237-0245]; [0178-0181]); *and*

a configurator generator that is adapted to provide a configurator (e.g., FIG. 8, Configuration Server 336, [0151]-[0152]) *that loads configuration information for use by the controller from a configuration file* (e.g., FIG. 15, Configuration File/DOM tree, [0326], [0338]);

that originated from a backend data store (e.g., FIG. 15, Configuration File/DOM tree originated/stored in Configuration Back End 337, [0338], [0343], [0346]), *and*

wherein the configurator stores the configuration information for subsequent access (e.g., FIG. 15, caching configuration information in cache 1560/DOM tree cache 1570, [0327]-[0328], [0364]).

Claim 2:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configuration file is a text properties configuration file* (e.g., Configuration File/DOM tree as an XML file, [0158] and [0237]; text properties such as text or image in Table 69, [0600]; displayed text size in [0324], type of user browser in → type of text in [0250], text fonts in [0185]).

Claim 3:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configurator is adapted to store the configuration information as a singleton object* (e.g., a single DOM tree 1570 (a singleton object) cached in cache 1560, [0327-0329]).

Claim 4:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configuration information comprises error handling information* (e.g., [0170], [0460], and [0492]).

Claim 5:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configuration information comprises log processing information* (e.g., [0409]).

Claim 6:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configuration information comprises data that is specific to each of a plurality of portals* (e.g., [0156], [0021-0023], and [0324]).

Claim 7:

The rejection of claim 1 is incorporated. Hutsch also discloses *the configurator is adapted to read the configuration information upon initialization of the controller (e.g., view/modify/recompile configuration files before restarting/re-executing Web Server, [0156], [0426], and [0465]).*

Claim 8:

Hutsch discloses *a method of creating web applications, the method comprising:
creating, with a processor-based device, a controller (e.g., FIG. 8, Web Server 320, [0124], [0145]-[0146]) that receives a request for data from a user and responds to the request by sending information to the user (e.g., FIG. 8, Web Server 320 provides web applications to user Web Browser 304 after receiving HTTP requests from said user Web Browser 304, [0145]-[0146]; FIG. 15, [0237-0245]; [0178-0181]);
and*

*providing a configurator (e.g., FIG. 8, Configuration Server 336, [0151]-[0152]) that loads configuration information for use by the controller from a configuration file and
the configuration file that originated from a backend data store (e.g., FIG. 15, Configuration File/DOM tree originated/stored in Configuration Back End 337, [0338], [0343], [0346]);
wherein the configurator stores the configuration information for subsequent access (e.g., FIG. 15, caching configuration information in cache 1560/DOM tree cache 1570, [0327]-[0328], [0364]).*

Claim 9:

The rejection of claim 8 is incorporated. Hutsch also discloses *defining the configuration file to be a text properties configuration file (e.g., Configuration File/DOM tree as an XML file, [0158] and [0237]; text properties such as text or image in Table 69, [0600]; displayed text size in [0324], type of user browser in → type of text in [0250], text fonts in [0185]).*

Claim 10:

The rejection of claim 8 is incorporated. Hutsch also discloses *adapting the configurator to store the configuration information as a singleton object* (e.g., a single DOM tree 1570 (a singleton object) cached in cache 1560, [0327-0329]).

Claim 11:

The rejection of claim 8 is incorporated. Hutsch also discloses *defining the configuration information to comprise error handling information* (e.g., [0170], [0460], and [0492]).

Claim 12:

The rejection of claim 8 is incorporated. Hutsch also discloses *defining the configuration information to comprise log processing information* (e.g., [0409]).

Claim 13:

The rejection of claim 8 is incorporated. Hutsch also discloses *defining the configuration information to comprise data that is specific to each of a plurality of portals* (e.g., [0156], [0021-0023], and [0324]).

Claim 14:

The rejection of claim 8 is incorporated. Hutsch also discloses *adapting the configurator to read the configuration information upon initialization of the controller* (e.g., view/modify/recompile configuration files before restarting/re-executing Web Server, [0156], [0426], and [0465]).

Claim 15:

Hutsch discloses *a system stored on a machine readable medium for creating web applications, the system comprising:*

means for creating a controller that is adapted to receive a request for data from a user and respond to the request (e.g., FIG. 8, Web Server 320 provides

web applications to Client Browser 304 after receiving HTTP request, [0237-0245]; [0178-0181]);

the configuration file that originated from a backend data store (e.g., FIG. 15, Configuration Back End Databases 337, [0326]; Cache 1560 for data originated from the Configuration Back End Databases 337, [0346-0356]); caching configuration information for subsequent access, [0239], [0327-0329]); and means for creating a configurator that loads configuration information for use by the controller from a configuration file and wherein the configurator stores the configuration information for subsequent access (e.g., [0239]; FIG. 8, Configuration Service 336 having configuration information, [0156]; configuration information stored in user/application profiles, [0310]-[0318]; user/application profiles as XML files, [0321]-[0323]; [0239])

Claim 16:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configuration file is a text properties configuration file (e.g., Configuration File/DOM tree as an XML file, [0158] and [0237]; text properties such as text or image in Table 69, [0600]; displayed text size in [0324], type of user browser in → type of text in [0250], text fonts in [0185]).*

Claim 17:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configurator is adapted to store the configuration information as a singleton object (e.g., a single DOM tree 1570 (a singleton object) cached in cache 1560, [0327-0329]).*

Claim 18:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configuration information comprises error handling information (e.g., [0170], [0460], and [0492]).*

Claim 19:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configuration information comprises log processing information* (e.g., [0409]).

Claim 20:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configuration information comprises data that is specific to each of a plurality of portals* (e.g., [0156], [0021-0023], and [0324]).

Claim 21:

The rejection of claim 15 is incorporated. Hutsch also discloses *the configurator is adapted to read the configuration information upon initialization of the controller* (e.g., view/modify/recompile configuration files before restarting/re-executing Web Server, [0156], [0426], and [0465]).

Claim 22:

Hutsch discloses *a machine readable medium, comprising:*

a controller generator stored on the machine readable medium, the controller generator being adapted to provide a web application with a controller that receives a request for data from a user and responds to the request by sending information to the user (e.g., FIG. 8, Web Server 320 provides web applications to Client Browser 304 after receiving HTTP request, [0237-0245]; [0178-0181]); *and*

a configurator generator stored on the machine readable medium, the configurator generator being adapted to provide a configurator (e.g., FIG. 8, Configuration Server 336, [0151]-[0152]) *that loads configuration information for use by the controller from a configuration file* (e.g., FIG. 15, Configuration File/DOM tree, [0326], [0338]) *that originated from a backend data store* (e.g., FIG. 15, Configuration File/DOM tree originated/stored in Configuration Back End 337, [0338], [0343], [0346]), *and*

wherein the configurator stores the configuration information for subsequent access (e.g., FIG. 15, caching configuration information in cache 1560/DOM tree cache 1570, [0327]-[0328], [0364]).

Claim 23:

The rejection of claim 22 is incorporated. Hutsch also discloses *the configurator generator is adapted to produce a configurator that stores the configuration information as a singleton object* (e.g., a single DOM tree 1570 (a singleton object) cached in cache 1560, [0327-0329]).

Claim 24:

The rejection of claim 22 is incorporated. Hutsch also discloses *the configurator generator is adapted to produce a configurator that reads the configuration information upon initialization of the controller* (e.g., view/modify/recompile configuration files before restarting/re-executing Web Server, [0156], [0426], and [0465]).

Conclusion

9. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/

Examiner, Art Unit 2192

/Tuan Q. Dam/

Supervisory Patent Examiner, Art Unit 2192